UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,793	12/08/1999	Christopher L. Knauft	MEDIDNA.049A	6923

30948	7590	12/15/2004

CLOCK TOWER LAW GROUP
2 CLOCK TOWER PLACE, SUITE 255
MAYNARD, MA 01754-2545

EXAMINER
NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
Office Action Summary		09/456,793	KNAUFT ET AL.
		Examiner	**Art Unit**	
		Maikhanh Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the following communications: Amendment filed 07/15/2004

to the original application filed 12/08/1999.

2.   Claims 1-27 are currently pending in this application. Claims 1, 12, 19 and 25 are

independent claims.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4.   Claims 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamanaka**

et al. (U.S. 5,983,247 –issued 11/1999) in view of **Sotomayor** (U.S. 5,708,825 – issued

01/1998).

As to independent claim 19:

a.   Yamanaka teaches a method of generating index information for graphical or audio objects *(e.g., generates the index information; col.14, lines 55-56 & Fig. 14)*, comprising: reading index information that is associated with a graphical or audio object *(e.g., the index information ...reads the tags in order from the start of the HTML document ...the tag is "<IMG>"; col.10, line 50-col.11, line 29)*.

b.   Yamanaka is silent on "dynamically generating an electronic document based at least in part upon the contents of the index information."

c.   Sotomayor teaches dynamically generating an electronic document based at least in part upon the contents of the index information *(e.g., automatically generating home pages containing various types of index information; col.4, lines 1-8 and lines 40-47)*.

d.   It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Yamanaka in the system of Sotomayor because it teaching would have provided the capability for providing viewer(s) with an indexed and/or hyperlinked view of a semantically-analyzed form of that document, wherein the viewer(s) can view, scan forward and backward, search for text strings as well as having semantically important key topics marked and indexed.

As to dependent claim 20:

Yamanaka teaches customizing, based at least in part upon the indexing characteristics of one or more information retrieval systems, the content of the electronic document *(col.11, lines 1-20)*.

As to dependent claim 21:

Yamanaka teaches the electronic document comprises a HyperText Markup Language file *(col.7, lines 40-53 and Figs.3-6).*

As to dependent claim 22:

Yamanaka teaches the audiovisual object comprises a bitmap image *(col.11, lines 22-29).*

As to dependent claim 23:

Yamanaka teaches the graphical object is a multimedia presentation *(e.g., a presentation of the content of the audio information; col.12, lines 56-59 & Fig. 8B).*

As to dependent claim 24:

Yamanaka teaches the graphical object is a streaming media file *(e.g., image files; col.7, lines 40-53/ "V1" is a video elementary stream; col.20, lines 6-67).*

<u>As to independent claim 25:</u>

a.   The rejection of independent claim 19 above is incorporated herein in full. Additionally, claim 19 further recites "converting at least a portion of a graphical or audio object into index information."

b.   Yamanaka teaches converting at least a portion of a graphical or audio object into index information *(e.g., converting multimedia data; col.1, line 5- col.2, line 28/ generated index information; col.10, lines 14-55 & col.14, lines 42-62).*

As to dependent claims 26-27:

They include the same limitations as in claims 20-21, and are similarly rejected under the same rationale.

5.   Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamanaka et al.** in view of **Durst, Jr. et al.** (U.S. 6,542,933 – filed 04/2000), provisional application filed 04/1999.

As to independent claim 1:

a.   Yamanaka teaches a method of generating index information for audiovisual objects *(e.g., generates the index information; col.14, lines 55-56 & Fig. 14)*, comprising: converting at least a portion of an audiovisual object into index information *(e.g., converting multimedia data; col.1, line 5- col.2, line 28/ generated index information; col.10, lines 14-55 & col.14, lines 42-62)*.

b.   Yamanaka does teach "index information", but is silent on "obfuscating at least a portion of the index information so that the intelligibility of the contents of the index information is reduced."

c.   Durst teaches obfuscating at least a portion of the index information so that the intelligibility of the contents of the index information is reduced *(e.g., both linkage codes and user's ID are blinded before being issued or displayed. The 'blinding' operation is form of obfuscating and/or encryption ... blinding is used for revenue protection; col.18, line 60-col.19, line 7 and col.28, lines 3-11)*.

d.   It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Durst and Yamanaka because it would have provided the capability for forcing a user to see a certain information, should it be sufficiently important.

As to dependent claim 2:

Yamanaka teaches dynamically generating an electronic document which comprises at
least a portion of the index information *(col.9, line 66-col.10, line 5 & col.12, lines 41-*
59).

As to dependent claim 3:

Yamanaka teaches customizing, based at least in part upon the indexing characteristics of
one or more information retrieval systems, the content of the electronic document *(col.11,*
lines 1-20).

As to dependent claim 4:

Yamanaka teaches the electronic document comprises a HyperText Markup Language
file *(col.7, lines 40-53).*

As to dependent claim 5:

Yamanaka teaches the audiovisual object comprises a bitmap image *(col.11, lines 22-29).*

As to dependent claim 6:

Yamanaka teaches the audiovisual object comprises music *(col.7, lines 38-39/ col.11,*
lines 42-51/col.1, lines 51-55).

As to dependent claim 7:

Yamanaka teaches converting at least a portion of the audiovisual object into index
information text comprises identifying one or more words in the lyrics of the music *(Fig.*
8B).

As to dependent claim 8:

Yamanaka teaches the audiovisual object comprises a multimedia presentation *(col.12,*
lines 56-59 & Fig. 8B).

As to dependent claim 9:

Yamanaka teaches converting at least a portion of a graphical or audio object into index

information comprises reading close captioned information that is associated with the

audiovisual object *(Abstract).*

As to dependent claim 10:

Yamanaka teaches the audiovisual object comprises a streaming media file *(col.7, lines*

39-63 / col.20, lines 6-67).

As to dependent claim 11:

It includes the same limitations as in claim 9, and is similarly rejected under the same

rationale.

As to independent claim 12:

a.   The rejection of independent claim1 above is incorporated herein in full.

        Additionally, claim 12 further recites:

        (i)   reading index information that is associated with a graphical or audio

                object; and

        (ii)   transmitting the obfuscated index information to an information retrieval

                system.

b.   Yamanaka teaches:

        (i)   reading index information that is associated with a graphical or audio

                object *(e.g., the index information ...reads the tags in order from the start*

                of the HTML document ...the tag is "<IMG>"; col.10, line 50-col.11, line

                29 and Fig.14); and

(ii)   transmitting the index information to an information retrieval system

(Figs. 11A-B & 12).

c.   Yamanaka does teach "transmitting the index information to an information

retrieval system, but is silent on "the obfuscated information".

d.   Durst teaches the obfuscated index information *(e.g., both linkage codes and*

user's ID are blinded before being issued or displayed. The 'blinding' operation

is form of obfuscating and/or encryption ... blinding is used for revenue

protection; col.18, line 60-col.19, line 7 and col.28, lines 3-11).

e.   It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to combine the teachings of Durst and Yamanaka because it

would have provided the capability for forcing a user to see a certain information,

should it be sufficiently important.

As to dependent claims 13-16:

They include the same limitations as in claims 2-5, and are similarly rejected under the

same rationale.

As to dependent claim 17:

Yamanaka teaches the graphical object is a multimedia presentation *(col.12, lines 56-59*

& Fig. 8B).

As to dependent claim 18:

Yamanaka teaches the graphical object is a streaming media file *(col.7, lines 40-53 &*

col.20, lines 6-67).

Response to Arguments

6.   Applicant's arguments filed 07/15/2004 have been fully considered but they are not

persuasive.

Applicant argues that *Yamanaka fails to show "dynamically generating an electronic*

document based at least in part upon the contents of the index information." (Remarks,

page 4, last para.)

In response, the teachings of the newly applied prior art (Sotomayor) *"automatically*

generating home pages containing various types of index information"(col.4, lines 1-8

and lines 40-47) meet "dynamically generating an electronic document based at least in

part upon the contents of the index information " as claimed by Applicant.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-

4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30

pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph H Feild can be reached on (571) 272-4090.

The fax phone number for the organization where this application or proceeding is

assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen
December 8, 2004

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER